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EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/733,891

Applicant(s)
Kaddeche et al.

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 29, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152) _____
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

[Handwritten signature]
12-10-03

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SECOND ACTION REJECTION

(Paper#8)

STATUS

1. Claims 1-3 & 5-14 are pending.

DRAWINGS

2. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM OBJECTIONS—37 CFR 1.75

3. **Objections Withdrawn.**

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CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

4. Claims 1-3, 6-8 & 11-14 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 1 & 11, as drafted said claims are not limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) **within the technological arts** (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA

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1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

As per claims 2-3, 6-8 & 12-14 said claims are rejected under 35 U.S.C. 101 for the same reasons as claims 1 & 11 because said claims 2-3, 6-8 & 12-14 depend from claims 1 & 11 and subsequent base claims depending from claims 1 & 11. Further more, claims 2-3, 6-8 & 12-14 merely contain non-functional descriptive material.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3 & 5-14 are rejected under 35 U.S.C. §103(a) as being obvious over Root 6,013,007 (1/11/2000) [US f/d: 03/26/1998] (herein referred to as “Root”).

As per claim 1, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col .4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of targeting an Internet messaged[sic] to an Internet client based on geographic information of the Internet client. . . .”

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred

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embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular address . . . obtaining an IP address from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client’s IP address with the lookup table . . . [and] transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client.”

Root lacks an explicit recitation of the “obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular address . . . obtaining an IP address

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from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client's IP address with the lookup table . . . transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client. . . ." even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with "obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular address . . . obtaining an IP address from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client's IP address with the lookup table . . . transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client. . . ." because such selection would have provided "*a system by which advertisers*

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can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .” (see Root (col. 2 ll. 40-43).

As per claim 2, Root shows the method of claim 1. (See the rejection of claim 1 supra).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client’s geographical location.”

Root lacks an explicit recitation of the “wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client’s geographical location. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client’s geographical location. . . .” because such selection would have provided “*a system by which advertisers can present geographically*

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and demographically targeted messages to a highly well defined group of potential customers. . . .” (see Root (col. 2 ll. 40-43).

As per claims 3 & 5-8, Root shows the method of claim 1 and subsequent base claims depending from claim 1.

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows elements that reasonably suggest the elements and limitations of claims 3-8.

Root lacks an explicit recitation of the elements and limitations of claims 3 & 5-8 even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with the elements and limitations of claims 3 & 5-8 because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .”* (see Root (col. 2 ll. 40-43).

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As per claim 9, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of targeting at least one geographically based message to at least one Internet client of at least one web site server. . . .”

Recall, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space from at least one web site . . . obtaining an IP address of the Internet client when the Internet client visits the web site. . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet client through the web site, wherein the first message is related to the geographic location of the Internet client.”

Root lacks an explicit recitation of “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space form at least one web site . . . obtaining an IP address of the Internet client when the Internet

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client visits the web site. . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet client through the web site, wherein the first message is related to the geographic location of the Internet client. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space from at least one web site . . . obtaining an IP address of the Internet client when the Internet client visits the web site . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet client through the web site, wherein the first message is related to the geographic location of the Internet client. . . .” because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43).

As per claim 10, Root shows the method of claim 9. (See the rejection of claim 9 supra).

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Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a document, or a map.”

Root lacks an explicit recitation of the “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a document, or a map. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a document, or a map. . . .” because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43).

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As per claim 11, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of using a computer to transmit targeted information to an Internet client of a web server. . . .”

Recall, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “collecting IP addresses from a plurality of Internet clients . . . collecting geographical addresses from the plurality of Internet clients . . . geocoding each of the collected geographical addresses to generate location information for each of the geographical attributes . . . generating a look-up table substantially correlating the IP addresses to the location information . . . collecting the IP address of the Internet client . . . generating a location information for that Internet client based on the look-up table . . . retrieving a target information relating to the location information . . . [and] transmitting the targeted information to the Internet client while the Internet client is accessing the web server.”

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Root lacks an explicit recitation of the “collecting IP addresses from a plurality of Internet clients . . . collecting geographical addresses from the plurality of Internet clients . . . geocoding each of the collected geographical addresses to generate location information for each of the geographical attributes . . . generating a look-up table substantially correlating the IP addresses to the location information . . . collecting the IP address of the Internet client . . . generating a location information for that Internet client based on the look-up table . . . retrieving a target information relating to the location information . . . [and] transmitting the targeted information to the Internet client while the Internet client is accessing the web server. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “collecting IP addresses from a plurality of Internet clients . . . collecting geographical addresses from the plurality of Internet clients . . . geocoding each of the collected geographical addresses to generate location information for each of the geographical attributes . . . generating a look-up table substantially correlating the IP addresses to the location information . . . collecting the IP address of the Internet client . . . generating a location information for that Internet client based on the look-up table . . . retrieving a target information relating to the location information . . . [and] transmitting the targeted

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information to the Internet client while the Internet client is accessing the web server. . . .” because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43)).

As per claims 12-13, Root shows the method of claim 11. (See the rejection of claim 11 supra).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests the elements and limitations of claims 12-13.

Root lacks an explicit recitation of the elements and limitations of claims 12-13, even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

“Official Notice” is taken that both the concepts and the advantages of the elements and limitations of claims 12-13 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43)).

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As per claim 14, Root shows the method of claim 3.

Root (col. 9, ll. 51-62) discloses: “*An E-mail message can be sent. . . .*”

Root (col. 9, ll. 51-62; the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows elements that reasonably suggest the elements and limitations of claim 14.

Root lacks an explicit recitation of the elements and limitations of claim 14 even though Root (col. 9, ll. 51-62; the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with the elements and limitations of claim 14 because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43)).

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RESPONSE TO ARGUMENTS

6. Applicant's arguments/request for reconsideration (Amendment A, paper#7, filed 09/29/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

As per claims 1-3 & 5-14, Applicant's arguments/request for reconsideration (Amendment A, paper#7, p. 6) admits that the claimed term "'address' broadly refers to any attribute. . . ."; and (Amendment A, paper#7, p. 8) admits that "both the claimed invention and Root seek to generate targeted advertisements to Internet users as their ultimate goal. . . ."

The prior Office action as well as the instant Office action contend that the claims of the instant invention as drafted are over broad.

In response to Applicant's arguments (Amendment A, paper#7, p. 10) which asserts that the Root reference teaches "away from the. . . ." claimed invention, it is well settled in the law that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments." (See *In re Susi*, 169 USPQ 423 (CCPA 1971). Note: The prior Office action as well as the instant Office action contend that the claims of the instant invention as drafted are over broad.

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In response to Applicant's arguments (Amendment A, paper#7, p. 10) which asserts that there is "no motivation to modify to construct the claimed invention. . . . [and the prior Office action] has failed to establish a prima facie case of obviousness. . . ." it is well settled that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." (See MPEP 707.02(j)).

Also, it is well settled that in order to establish motivation to modify or combine references, "it is not necessary that a reference actually suggest changes or possible improvements which Applicant made." (See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). In other words the rationale for motivation to modify or combine references does not have to suggest the invention as recited in the claim.

Also, it is well settled in the law that "There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.' *In re Ruffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). . . ." (See MPEP 2143.01). Furthermore, the prior Office action as well as the instant Office action rely on knowledge generally available to one of ordinary skill in the art and assert that the modified teachings of the Root reference in conjunction with the knowledge of one of ordinary skill in the art either teach or suggest all of the elements and limitations of the

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instant invention. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01). In the prior Office Action obviousness rejections, the Examiner meets the requirements of the motivation test for combining the prior art references by quoting from the reference cogent reasons (i.e., motivation) to combine the teachings; furthermore the Examiner identifies how the references either teach or suggest the elements of the claims of the instant invention. Furthermore, the prior Office action as well as the instant Office action rely on knowledge generally available to one of ordinary skill in the art and assert that the teachings of the references combined with the knowledge of one of ordinary skill in the art either teaches or suggests all of the elements and limitations of the instant invention. Therefore, based upon the above considerations, *prima facie* obviousness is established in the prior Office Action based upon a proper showing of motivation to combine the prior art references to come up with Applicant’s invention.

As per dependent claims 12-13, Applicant's arguments (Amendment A, paper#7) fail to present an appropriate challenge to the taking of Official/Judicial Notice because

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Applicant's arguments do not demand a reference in support of the "[Official/Judicial] notice." (MPEP 2144.03 (August 2001) p. 2100-129). Applicant also has failed to specifically point out the supposed errors in the prior Office action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

Therefore, the "Official Notice" or common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant's traversal is inadequate, and no further references in support of the official notice are required.

CONCLUSION

7. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Art Unit: 3622

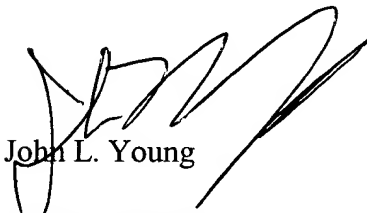
Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

December 10, 2003